

## **REMARKS**

### **I. Introduction**

With the cancellation without prejudice of claims 31 to 34, claims 18 to 30 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

### **II. Rejection of Claims 18 to 30 Under 35 U.S.C. § 112**

Claims 18 to 30 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. As regards claim 18, the Examiner requests clarification regarding the connection of the solenoid and the contact element. While Applicants do not agree with the merits of this rejection, to facilitate matters, the Examiner will note that claim 18 has been amended herein without prejudice to recite that the contact element includes a connecting part attached to the housing body and that "the solenoid, via the at least two relay connectors, and the contact element, via the at least two contact tabs, are connected to each other by the connecting part of the contact element." Applicants respectfully submit that the foregoing amendments obviate the present rejection. Withdrawal of the present rejection is therefore respectfully requested.

Further, as regards claim 21, the Examiner asserts that "[Applicants] should clarify the structure and connection of the contact elements." Claim 21 recites that the at least two contact tabs are connected to each other by a web. Applicants respectfully submit that claim 21 is sufficiently definite for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the "focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement

of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, *inter alia*, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

In this regard to the connection of the contact tabs, the Specification states at page 7, lines 22 to 27 as follows:

Figure 4B shows a schematic view of contact element 9 after contact tabs 10 have been extrusion-coated with plastic. A first plastic web 15 is formed in the area of holes 14a. The plastic enters holes 14a and holds contact tabs 10 a certain distance apart, determined by the width of web 12. A connecting part 16 according to the present invention is injection-molded onto plastic web 15.

Respectfully, in light of the above description in the Specification and the Figures one skilled in the art would clearly understand the recitation “at least two contact tabs are connected to each other by a web,” as recited in claim 21.

In view of the foregoing, withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 18 to 30 are respectfully requested.

### **III. Rejection of Claims 18, 19 and 25 to 27 Under 35 U.S.C. § 102(e)**

Claims 18, 19 and 25 to 27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,050,245 (“Cook et al.”). Applicants respectfully submit that claims 18, 19 and 25 to 27 are not anticipated by Cook et al. for the following reasons.

Claim 18 relates to a connectable solenoid for use with a housing body. Claim 18 recites that the connectable solenoid includes a solenoid having a substantially cylindrical hollow bobbin made of an insulating material adapted to be

coupled to the housing body and provided with at least two relay connectors anchored in an end area of the bobbin and projecting axially therefrom. Claim 18 has been amended herein without prejudice to recite that the hollow bobbin is slidable onto the housing body. No new matter has been added. See the Specification, for example, at p. 8, lines 28 to 32. Claim 18 further recites that the connectable solenoid includes a contact element. Claim 18 has further been amended herein without prejudice to recite that the contact element has at least two contact tabs. No new matter has been added. See the Specification, for example, at p. 7, lines 7 to 8. Claim 18 further recites that the solenoid and the contact element are two separate components. Claim 18 has further been amended herein without prejudice to recite that the solenoid, via the at least two relay connectors, and the contact element, via the at least two contact tabs, are connected to each other by a connecting part of the contact element. No new matter has been added. See the Specification, for example, at p. 8, line 28 to p. 9, line 9.

Cook et al. purportedly relate to a canister vent valve having at least one sensor and single electric actuator operatively connected to a single electrical connector. The Office Action alleges that elements 33a and 33b qualify as the housing, as recited in claim 18. Claim 18 has been amended herein without prejudice to recite that the cylindrical hollow bobbin is slidable onto the housing body. Respectfully, solenoid 62 of Cook et al. is disposed within housings 33a and 33b, *i.e.*, solenoid 62 is not slidable onto housings 33a and 33b. See Figures 2 and 3 and col. 4, lines 4 to 5. Therefore, Cook et al. do not disclose all of the limitations of amended claim 18.

The Office Action further alleges that leads 94 qualify as the solenoid relay connectors and electric terminals 96 qualify as the contact element, as recited in claim 18. Respectfully, nowhere do Cook et al. disclose, or even suggest, that a solenoid, via at least two relay connectors, and a contact element, via at least two contact tabs, are connected to each other by a connecting part of the contact element attached to a housing body, as recited in amended claim 18. As seen in Figure 3, electric terminals 96 are directly connected on one end to leads 94. See also col. 4, line 58 to col. 5, line 5. Therefore, Cook et al. do not disclose all of the limitations of amended claim 18.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of

Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Cook et al. do not disclose, or even suggest, all of the limitations of amended claim 18. Therefore, it is respectfully submitted that Cook et al. do not anticipate amended claim 18.

As for claims 19 and 25 to 27 which ultimately depend from claim 18 and therefore include all of the limitations of claim 18, Applicants submit that Cook et al. do not anticipate these dependent claims at least the reasons provided above in support of the patentability of claim 18.

Applicants submit the following additional arguments in support of the patentability of claims 25 and 27. In regard to claim 25, nowhere do Cook et al. disclose, or even suggest, that the connecting part partially surrounds the inner housing body. In regard to claim 27, nowhere do Cook et al. disclose, or even suggest, that the connecting part surrounds the inner housing body in an angular range that is greater than 180°. Therefore, it is respectfully submitted that Cook et al. do not anticipate claims 25 and 27 for these additional reasons.

#### **IV. Rejection of Claims 21, 22 and 28 Under 35 U.S.C. § 103(a)**

Claims 21, 22 and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Cook et al. Applicants respectfully submit that claims 21, 22 and 28 are not rendered unpatentable by Cook et al. for the following reasons.

Claims 21, 22 and 28 ultimately depend from claim 18 and therefore include all of the limitations of claim 18. Applicants respectfully submit that these claims are patentable over Cook et al. for at least the same reasons asserted above with respect to claim 18.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071,

5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Cook et al. do not disclose all of the limitations of claim 18, from which claims 21, 22 and 28 ultimately depend. Therefore, it is respectfully submitted that Cook et al. do not render unpatentable claims 21, 22 and 28, which ultimately depend from claim 18. Therefore, withdrawal of this rejection is respectfully requested.

**V. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter contained in claims 23, 24, 29 and 30. In this regard, the Examiner will note that claim 23 has been rewritten herein in independent form to include all of the limitations of its respective base claim and any intervening claims. It is therefore respectfully submitted that claim 23 is in condition for immediate allowance. Since claims 24, 29 and 30 ultimately depend from claim 23, it is respectfully submitted that these dependent claims are also in condition for immediate allowance.

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: 4/1/04

By: 

Richard L. Mayer  
Reg. No. 22,480  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**

Bx 1000  
#35,952